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Application No. 10/038,578

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Remarks/Arguments

In response to the Office Action, the applicant offers the following remarks. Claims 1 to 4, 6, 10, 11, 13 and 14 have been amended, claims 5, 7 to 9 and 15 to 20 have been withdrawn and claims 21 to 31 have been added. Claims 1 to 6, 10 to 14 and 21 to 31 are pending in the present patent application.

1. Claim Objections-Minor Informalities

The Office Action objects to claim 1 and indicates that the word "thereto" should be replaced by "thereinto". Claim 1 has been amended and the word "thereto" has been deleted in claim 1, rendering this objection moot.

2. Rejections Under Sections 102(b) and 103(a)

The Office Action rejects claims 1 to 4, 6, 10, 11, 13 and 14 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,823,543 issued to Burns et al. ("Burns et al."). The Office Action rejects claims 1 and 2 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,961,131 issued to Hilgarth ("Hilgarth"). Claim 1 is also rejected under 35 U.S.C. § 102(b) as being anticipated by any one of Canadian Patent Application 2,201,814 in the name of Chicoine ("Chicoine"), Canadian Patent Application 2,295,778 of Fullum ("Fullum") or French Patent Application 2,742,063 of Jourmard ("Jourmard"). Lastly, the Office Action rejects claims 5 and 12 under 35 U.S.C. § 103(a) as being unpatentable over Burns et al. in view of U.S. Patent 6,343,639 issued to Kilgore et al.

The applicant respectfully requests reconsideration of these rejections in view of the following remarks.

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3. Patentability of Amended Independent Claim 1

According to MPEP § 706.02, in order to reject a claim under 35 U.S.C. § 102(b) as being anticipated by a reference, the Examiner must determine that such reference teaches every aspect of the claimed invention either explicitly or impliedly

There are no grounds for an anticipation rejection of amended claim 1 since none of the cited references teaches the following highlighted features:

1. An in-line roller skate comprising:

(a) a skate boot comprising an upper for enclosing and supporting a human foot, said upper comprising a bottom portion;

(b) a chassis carrying a plurality of aligned wheels, said chassis being mounted to said skate boot; and

(c) an outsole covering said bottom portion of said upper, said outsole comprising a heel portion comprising a cavity and a resilient component inserted within said cavity for reducing shocks and vibrations transferred from said chassis to the human foot.

a) Rejection based upon Burns et al.

Burns et al. discloses an elastomeric shock absorbing material 38 mounted in the sockets 40, 42 of the pivot member 32 and the bracket 31 and an elastomeric cylinder 58 mounted in the sockets 60, 61 of the pivot member 54 and the bracket 52.

Official Action indicates that: "*Burns et al. discloses [...] [an] outsole further including a resilient component (38 and/or 58; refer col. 4, lines 8-9, and lines 18-19) inserted thereinto*".

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The applicant realizes that there is confusion of terms since it appears that the rejection is based on the assumption that the brackets 31, 52 form part of the outsole of the skate shoe 13.

As indicated by the Examiner, the outsole of the skate shoe 13 is not separately numbered. It is understood that the outsole forms part of the skate shoe 13 and that the pivot members 32, 54 and the brackets 31, 52 are mounted on the outsole and do not therefore form part of such outsole. The Examiner will indeed appreciate that the pivot members 32, 54 and the brackets 31, 52 form part of the double pivot mechanism 14, 16 of the shock absorber system 12 that are respectively attached to the forward end of the skate shoe 13 and the rearward portion of the skate shoe 13 (Column 3, lines 57-64). Also note that the inventors specifically indicate that: "*Double pivot mechanism 14 includes a first pivot 30 mounted to a bracket 31 on the bottom of the skate shoe 13. Pivotably mounted at pivot 30 is pivot member 32 which itself contains a second pivot 34 that is attached to frame 20 of truck device 18.*" (Column 3, line 67; Column 4, lines 1-4).

The pivot members 32, 54 and the brackets 31, 52 connect the bottom of the skate shoe 13 to the chassis 20, they form part of the double pivot mechanisms 14, 16, they do not form part of the outsole and they cannot therefore be identified as an outsole comprising a heel portion with a cavity and a resilient component inserted within the cavity for reducing shocks and vibrations transferred from the chassis to the human foot as recited in claim 1.

b) **Rejection based upon Hilgarth**

Hilgarth discloses a skate 10 having a shoe 11, a support (chassis) 12, an extension 19 and an elastic foil 21 connecting the support 12 and the extension 19. The elastic foil 21 is mounted between the shoe 11 and the chassis 12.

Official Action indicates that: "*Hilgarth discloses [...] [an] outsole further including a resilient component (21) inserted' thereinto*". It thus appears that the rejection is based on the assumption that the extension 19 forms part of the outsole of the skate boot upper. It is however submitted that the extension 19 connects the skate boot to the chassis via the elastic foil 21 and

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this extension cannot be identified as an outsole covering the bottom portion of the skate boot upper as recited in claim 1. Also note that the inventor identifies the extension 19 as being a component that is separate from the outsole: "*the extension 19 consists of a central protrusion 119 defining with the sole of the shoe 11, a slot 24; the elastic foil 21 is of the type shown in FIG. 2.*" (Column 4, lines 47-49).

Moreover, Hilgarth does not teach an outsole comprising a heel portion with a cavity and a resilient component inserted within the cavity for reducing shocks and vibrations transferred from said chassis to the human foot as recited in claim 1.

c) Rejection based upon Chicoine

Chicoine discloses a wheel mounting assembly 1 having a coil spring 91 for biasing the front portion of the wheel frame 19 downwardly from the sole member 3. The sole member 3 has a rear mounting bracket 11 having holes 63 for pivotally connecting the sole member 3 to the wheel frame 19.

Official Action indicates that Chicoine "*discloses [...] [an] outsole further including a resilient component inserted therein for reducing shocks and vibrations transferred from the chassis*". It thus appears that the rejection is based on the assumption that the rear mounting bracket 11 forms part of the outsole of the skate boot upper. It is however submitted that the mounting bracket 11 connects the skate boot to the chassis and this mounting bracket cannot be identified as an outsole covering the bottom portion of the skate boot upper as recited in claim 1.

Moreover, Chicoine does not teach an outsole comprising a heel portion with a cavity and a resilient component inserted within the cavity for reducing shocks and vibrations transferred from said chassis to the human foot as recited in claim 1.

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d) Rejection based upon Fullum

Fullum discloses an in-line roller skate comprising a boot 2, a chassis 3 and rear and front extensions 10, 11 interconnecting the boot 2 and the chassis 3. The skate also comprises a resilient member 35 located between the front portion of the skate boot 2 and the chassis 3.

Official Action indicates that Fullum "*discloses [...] [an] outsole further including a resilient component inserted thereinto for reducing shocks and vibrations transferred from the chassis*". It thus appears that the rejection is based on the assumption that the extensions 10, 11 form part of the outsole of the skate boot upper. It is however submitted that the extensions 10, 11 connect the skate boot to the chassis and they cannot be identified as an outsole covering the bottom portion of the skate boot upper as recited in claim 1.

Moreover, Fullum does not teach an outsole comprising a heel portion with a cavity and a resilient component inserted within the cavity for reducing shocks and vibrations transferred from said chassis to the human foot as recited in claim 1.

e) Rejection based upon Journard

Journard discloses a dampening 4 that is affixed on the rigid portion 9 of the outsole 3 and it does not therefore teach an outsole comprising a heel portion with a cavity and a resilient component inserted within the cavity for reducing shocks and vibrations transferred from said chassis to the human foot as recited in claim 1.

Hence, the applicant respectfully requests withdrawal of the Examiner rejection of independent claim 1 pursuant to 35 U.S.C. § 102(b). Because claims 2 to 6, 21 and 22 depend from independent claim 1 and include by reference all of the limitations recited in the independent claim, the applicant respectfully submits that these claims are also patentable.

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4. Patentability of Amended Independent Claim 10

According to MPEP § 706.02, in order to reject a claim under 35 U.S.C. § 102(b) as being anticipated by a reference, the Examiner must determine that such reference teaches every aspect of the claimed invention either explicitly or impliedly

There are no grounds for an anticipation rejection of claim 10 based upon Burns et al. since this cited reference does not teach the following highlighted features:

10. An in-line roller skate comprising:

- (a) a skate boot comprising an upper for enclosing and supporting a human foot, said upper comprising a bottom portion;
- (b) a chassis carrying a plurality of aligned wheels, said chassis being mounted to said skate boot; and
- (c) an outsole covering said bottom portion of said upper, said outsole comprising a heel portion comprising a fork-like structure having upper and lower platforms defining a space therebetween for receiving a resilient component, said upper and lower platforms branching out from an intersecting portion of said fork-like structure and being adapted to flex at said intersecting portion for compressing said resilient component when one of said aligned wheels abuts an obstacle.

Official Action indicates that: "*Burns et al. discloses [...] [an] outsole further including a resilient component (38 and/or 58; refer col. 4, lines 8-9, and lines 18-19) inserted thereinto [...] the outsole further comprising a heel portion (16) and a front portion (14), the heel portion (16) including a fork-like structure (combination of 52 and 54) having upper (52) and lower (54) platforms defining a space therebetween for receiving the resilient component (58)*". It thus appears that the rejection is based on the assumption that the bracket 52 and the pivot member 54

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form part of the outsole of the skate boot upper. As previously indicated, the bracket 52 and the pivot member 54 connect the bottom of the skate shoe 13 to the chassis 20, they form part of the double mechanism 16, they do not form part of the outsole of the shoe 13 and they cannot be identified as an outsole covering the bottom portion of the skate boot upper as recited in claim 10.

The examiner will also appreciate that Burns et al. does not disclose an outsole with a heel portion comprising a fork-like structure having upper and lower platforms defining a space therebetween for receiving the resilient component since the bracket 52 and the pivot member 54 cannot be identified as respective upper and lower platforms of the heel portion of the outsole. Indeed, as indicated above, these components form part of the double pivot mechanism 16 and they do not form part of the outsole of the shoe 13.

Moreover, Burns et al. does not disclose upper and lower platforms branching out from an intersecting portion of said fork-like structure and being adapted to flex at said intersecting portion for compressing the resilient component when one of said aligned wheels abuts an obstacle as recited in claim 10.

Hence, the applicant respectfully requests withdrawal of the Examiner rejection of independent claim 10 pursuant to 35 U.S.C. § 102(b). Because claims 11 to 14 and 23 depend from independent claim 10 and include by reference all of the limitations recited in the independent claim, the applicant respectfully submits that these claims are also patentable.

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5. Patentability of New Claim 24

None of the cited references discloses the following highlighted features of new claim 24:

24. An in-line roller skate comprising:

- (a) a skate boot having an upper for enclosing and supporting a human foot, said upper comprising a bottom portion;
- (b) a chassis carrying a plurality of aligned wheels, said chassis being mounted to said skate boot; and
- (c) an outsole covering said bottom portion of said upper, said outsole comprising a heel portion having a cavity and a resilient component entirely confined within said cavity.

The applicant therefore submits that new independent claim 24 is patentable over the cited references. Because claims 25 to 31 depend from independent claim 24 and include by reference all of the limitations recited in the independent claim, the applicant respectfully submits that these claims are also patentable

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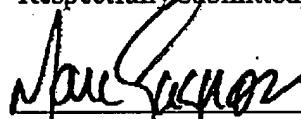
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Conclusion

In view of the above amendments and remarks, it is submitted that claims 1 to 6, 10 to 14 and 21 to 31 are not anticipated by the cited references and that each of these pending claims is in condition for allowance. The rejection under 35 U.S.C. § 102(b) should be withdrawn. Favorable action is earnestly solicited.

Finally, the Examiner is invited to call the applicant's undersigned representative if any further amendment will expedite the prosecution of the application or if the Examiner has any suggestions or questions concerning the application or the present response. In fact, if the claims of the application are not believed to be in full condition for allowance, for any reason, the applicant respectfully requests the constructive assistance and suggestions of the Examiner in drafting one or more acceptable claims pursuant to MPEP § 707.07(j) or in making constructive suggestions pursuant to MPEP § 706.03 so that the application can be placed in allowable condition as soon as possible and without the need for further proceedings.

Respectfully submitted,



Marc Gagnon, Reg. No. 51,273
Attorney for the applicant

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SMART & BIGGAR
1000 de la Gauchetière Street West, Suite 3400
Montreal, Quebec, H3B 4W5, CANADA